



Attorney's Docket No.: 10830-054001 / A36-129092M/NY

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Rikihiro Lida Art Unit : 2828
Serial No. : 09/781,049 Examiner : Cornelius H. Jackson
Filed : February 9, 2001
Title : DFB LASER DRIVING DEVICE, DFB LASER DRIVING METHOD AND
STORAGE MEDIUM

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO ACTION OF NOVEMBER 29, 2004

In the Office action, the rejections of claims 1-3 as unpatentable over either U.S. Patent No. 6,563,846 (Kuo et al.) or U.S. Patent No. 6,449,077 (Broutin et al.) were maintained. The Examiner's response to the applicant's previously presented arguments are found at pages 5-6 of the Office action. As discussed below, applicant maintains the pending claims are patentable over the cited references and that the rejections should be withdrawn.

To anticipate a claim under 35 U.S.C. § 102, a single prior art reference must disclose "each and every" limitation of the claim. *See, e.g., Rockwell Int'l Corp. v. United States*, 47 USPQ2d 1027, 1031 (1998).

A claimed invention also is unpatentable under 35 U.S.C. § 103(a) if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person of ordinary skill in the art."

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Feb. 24, 2005

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Although a single prior art reference may, in appropriate circumstances, render a claim obvious, there must be showing of a suggestion or motivation to modify the teachings of that reference to the claimed invention in order to support the conclusion of obviousness. *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) (reversing conclusion of obviousness).

A single line in a reference may not be taken out of context and relied upon with the benefit of hindsight to show obviousness. *Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc.*, 796 F.2d 443, 448 (Fed. Cir. 1986). Similarly, boilerplate statements in a prior art reference that other embodiments and the like can be used are generally insufficiently specific to support a finding of obviousness. See, e.g., *Fromsom v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1447 (Fed. Cir. 1997). Moreover, the mere fact that the prior art reference could be modified does not satisfy the requirements for a finding of obviousness. *In re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990). Instead, the suggestion or motivation to modify the prior art must be “clear and particular.” See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, (Fed. Cir. 1998); *Teleflex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313 (Fed. Cir. 2002). As explained by the Court of Appeals for the Federal Circuit:

While the test for establishing an implicit teaching, motivation, or suggestion is what the combination of [] two statements of [the prior art reference] would have suggested to those of ordinary skill in the art, the two statements *cannot be viewed in the abstract*. Rather, they must be considered *in the context of the teaching of the entire reference*. Further, a rejection cannot be predicated on the mere identification in [the prior art reference] of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

In re Kotzab, 217 F.3d at 1371 (emphasis added).